

REMARKS

Status of Claims

Claims 1-6 are pending.

Summary of Office Action

References to paragraphs in the Office Action are referred to herein in parentheses identifying the appropriate paragraph, e.g. (para x).

The Request for Continued Examination filed July 12, 2004 was acknowledged by the Examiner (para 1).

The Examiner states that the Information Disclosure Statements filed on January 21, 2003 and February 25, 2002 failed to provide for PTO-1449 and the information therein not considered (para 2).

The Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,076,733 ("Wilz") in view of U.S. Patent No. 6,105,063 ("Hayes") (para 5).

The Office Action dated August 12, 2004 has been carefully reviewed. Reconsideration of the grounds of rejection is respectfully requested in view of the remarks herein.

Response to Office Action

A. Request for Continued Examination: The Applicants note with appreciation the Examiner's acknowledgement of the Request for Continued Examination.

B. Information Disclosure Statement: The Applicants note with appreciation the Examiner's review and consideration of the references cited in the Information Disclosure Statements mailed on May 12, 2003 and August 7, 2003. The Applicants respectfully request the

Examiner's review and consideration of the references cited in the Supplemental Information Disclosure Statement mailed on March 25, 2004 (recently filed under 37 C.F.R. § 1.97(c)).

Regarding the Supplemental Information Disclosure Statement and Form 1449 mailed on February 7, 2002, the Applicants note the Examiner has reviewed and considered the U.S. Patents cited in the statement and Form 1449 on June 15, 2003 as indicated by the Examiner's returned and initialed citations which were included in the Office Action dated June 23, 2003. The Applicants respectfully request the Examiner's review of the file wrapper concerning this Supplemental Information Disclosure Statement and the corresponding Form 1449.

Regarding the Supplemental Information Disclosure Statement and Form 1449 mailed on January 17, 2003, the Applicants respectfully submit that the corresponding Form 1449 was included in the filing. The Applicants have included in this office action a copy of the Supplemental Information Disclosure Statement and the corresponding Form 1449 mailed on January 17, 2003. Also included is a returned, stamped and dated post card indicating the PTO's receipt of these documents on January 21, 2003. The identifying data on the stamped post card are as follows: First class certificate of mailing; Supplemental Information Disclosure Statement with Authorization to Charge Deposit Account with copy (3 pages each for a total of 6 pages); Form 1449 (1 page); and 13 References. The Applicants respectfully request the Examiner's review and consideration of these documents.

C. Rejection of claims 1-6 under 35 U.S.C. § 103(a):

The Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Wilz in view of Hayes. The Applicants respectfully traverse the Examiner's rejection in this regard because the Examiner has failed to establish a *prima facie* case of obviousness. The MPEP states, in relevant part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2142.

The Applicants respectfully submit that, at a minimum, Wilz nor Hayes, alone or in combination, disclose, teach or suggest each and every element of claims 1-6.

1. Wilz and Hayes fail to disclose each and every element of claims 1-6

Wilz discloses a system and method for accessing information resources on the Internet. Col. 2, lines 47-48. The system is comprised of a user computer system, with a bar code symbol scanner and a GUI based web browser in communication with web servers via the Internet. Col. 6, lines 18-20. To access a web server, the user enters a linear or 2-D bar code symbol, via a bar code symbol scanner, encoded with information such as an Internet browser program command that writes the URL into the Goto window of the Internet browser; and the complete URL of the desired information resource. Col. 11, lines 6-20; Col. 13, lines 66-67.

The Applicants respectfully submit that Wilz fails to disclose each and every element of claims 1-3. Wilz does not disclose step (e) which requires “initiating transmission of the at least one selected network address from the network site to the end-user” based on “user profile information,” “information regarding a device employed by the user to access the network,” and context information comprising information regarding current or historical activity of the user on the network” as required by step (e) of claims 1, 2 and 3, respectively. The passage of Wilz, cited by the Examiner, discloses an Internet access system using a “URL-encoded bar code” symbol. Col. 10, line 63- Col. 15, line 52; Col. 15, line 52- Col. 20, line 67. The URL-encoded bar code symbol contains ASCII code elements representing “the complete URL of the Internet

information resource to be accessed”. Col. 11, lines 49-50; Col. 12, lines 56-57; Col. 13, lines 43-44; and Col. 14, lines 50-52. When the URL-encoded bar code symbol is scanned by a bar code reading device, the URL is read from the bar code and is automatically entered as input into the Goto window of the Internet browser program. Col. 17, line 67-Col. 18, line 2. This transmission of the URL by scanning a bar code containing the URL is not the same as transmitting a selected network address from the network site to the end user. Furthermore, the selected network address is based only on the information encoded in the bar code symbol not on a user profile, a user device nor a user’s current or past activity on the network.

Therefore, Wilz fails to disclose each and every limitation of claims 1-3. Likewise it fails to disclose each and every limitation of claims 4-6 which contains the same claim limitations as claims 1-3. Hayes, furthermore, does not make up for this deficiency.

Hayes discloses a client profile management system using a common repository for user configuration information. Col. 4, lines 11-13. Based on user preferences, the system allows a user to log-in from any computer in the system and for the computer to run automatically according to the user’s preferences. Col. 4, lines 15-16.

The Applicants respectfully submit that Hayes fails to disclose step (d) of claims 1, 2 and 3 that respectively, require “selecting at least one network address for each of the retrieved records” based on “user profile information,” “information regarding a device employed by the user to access the network,” and context information comprising information regarding current or historical activity of the user on the network.” As discussed in detail below, none of cited sections of Hayes disclose selecting a network address for a retrieved record as required for step (d) of claims 1-3. The Examiner has cited Col. 6, line 33 of Hayes for disclosing “user profile information” found in step (d) of claim 1. The cited section of Hayes discloses “[l]og-on

support” using a “user profile” not selecting a network address for a retrieved record based on user profile. Secondly, Col. 13, lines 18-24 were cited for disclosing step (d) of claim 2. This section of Hayes discloses using an terminal identifier to locate and retrieve the terminal’s configuration information. Col. 13, lines 17-23. This is not the same as selecting a network address for a retrieved record based on the user device used to access the network. Lastly, the Examiner cited Hayes section Col. 13, line 52 – Col. 14, line 27 for disclosing step (d) of claim 3. This section discloses a series of steps used to set up a terminal including the retrieval of a servlet’s URL which was previously loaded from the server. This is not the same as selecting a network address for a retrieved record based on current or past user activity.

Therefore, Hayes fails to disclose each and every element of claim 1-3. Likewise, Hayes fails to disclose each and every limitation of claims 4-6 which contains the same claim limitations as claims 1-3. Nor does Wilz make up for this deficiency as admitted by the Examiner.

2. The Examiner has failed to show a motivation to combine

The Examiner’s arguments did not contain any statements showing that a motivation to modify or combine is found in the reference teaching of Wilz with Hayes, the knowledge of persons of ordinary skill in the art or the nature of the problem.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and independent claims 1-6 are patentable.

Conclusion

In view of the foregoing remarks, it is submitted that pending claims 1-6 are in condition for allowance. Accordingly, reconsideration and allowance of claims 1-6 are requested.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection presented in the Office Action mailed August 12, 2004. The Examiner is invited to contact the undersigned at 215-963-5055 to discuss any matter concerning this Application.

The Commissioner is hereby authorized by this paper to charge any fees due in connection with the filing of the response to Deposit Account No. **50-0310**.

Respectfully submitted,

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By: _____



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